

REMARKS

The Examiner has rejected claims 25 and 28-30 under 35 U.S.C. 103(a) as being unpatentable over applicants admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Nervig (U.S. Patent No. 3,612,292) and Teter et al. (U.S. Patent No. 6,112,665). Applicants traverse this rejection.

In order to establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). However, Applicants do not believe that all of the claimed elements have been disclosed or are suggested by the cited references.

The Examiner states that Applicants' admitted prior art discloses the idea of placing paint chips in a rack, the idea of using paint chips with a plurality of colors on a single card and the idea of covering a paint chip with a single color. The Examiner further states that Applicants' prior art discussion does not disclose whether the display rack includes a wall that covers a chip section and the idea of placing perforations in the card to form a paint chip section. However, the Examiner has combined Applicants prior art statement with the teachings in Nervig and Teter to make the instant rejection. Applicants do not believe that independent claim 25 is obvious in light of the cited references. Accordingly, all of the claims depending from claim 25 also cannot be obvious, for at least the reason that claim 25 is not obvious.

In the Examiner's Response to Arguments, provided in the Office Action, the Examiner states that Nervig teaches that a portion of the card held in the rack is behind the wall of the Nervig display rack. Further, the Examiner states that Teter shows chip sections substantially extending to the bottom of the card and, as such, the chip sections closest to the bottom of the Teter color card would be covered by a wall when stored in a rack and the wall would thereby prevent accidental punching out of a chip section. The Examiner further states that the Applicants claims do not limit the card to just one color.

Applicants have amended the instant claims to recite that entire the first side of the color card is covered with a layer of a first colored coating composition. Moreover, Applicants have amended the claims to recite that the color card includes a single chip section.

The Teter reference contemplates that there is a perforated section in each of the multiple colored strips on the color card. Assuming, *arguendo*, that Teter even contemplates use of its disclosed color card within a display rack, Teter does not contemplate that all of the perforated sections in its color card are intended to be covered by a wall of a rack. In fact, the Examiner himself has stated that the chip sections in Teter “closest to the bottom of the card would be covered by a wall when stored in a rack,” thereby acknowledging that only those chip sections toward the top of the Teter color card would not be covered by the wall of a display rack. Through Applicants amendment that the claimed color card includes only one chip section and that the chip section is covered by the wall of the display unit, Applicants’ claim requires that all of the perforated sections, i.e., the single chip section, are covered by the wall of the display unit. Because Applicants’ color card includes only one chip section and that very chip section is covered by a wall, and the Teter color card (should the color cards even be used in a display rack) would clearly have those chip sections toward the top of the color card exposed and not covered by a wall, the Teter reference in combination with the other cited references does not disclose all of the elements of Applicants claim.

Additionally, as previously argued, it would not be obvious to modify the multiple-color card teaching of the Teter reference into a single-color card. Further, there is no motivation provided in the Nervig reference to provide for a wall that covers the single perforated chip section, as claimed in the Applicants claims. Nervig does not suggest that the dividers taught therein do more than maintain the spatial relationship between the cards inserted into a trough so that the cards are neatly stacked behind one another. In reference to Figure 1 of Nervig, Figure 1 does not suggest that use of the display device and placement of the walls will prevent dislodgement of a chip section from a paint color card. Although the general structure of the Nervig rack and Applicants’ drawings may appear to be similar, Nervig does not disclose or suggest that there is a necessary relationship between the front wall of the display unit and the perforated chip section of the housed color card, in part because Nervig never contemplates use of the display unit with a card which includes a perforated chip section.

As such, it is believed that the Teter reference, in combination with Nervig and Applicants prior art statement, does not disclose the combination of a display rack which includes a wall which prevents the single chip section of the single-color card from being grabbed by the prospective purchaser when the prospective purchaser removes the paint color

card from the display rack. Therefore, Applicants do not believe that the cited references disclose all of the claimed element of Applicants' claim 25. Furthermore, it is not obvious to combine the cited references. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Because Applicants do not believe that claim 25 is obvious in light of the cited prior art, claims 28-30, as well as any other claims depending from claim 25, should also not be obvious.

With respect to claims 26 and 27, Applicants traverse this rejection. As Applicants have stated above, independent claim 25 is not obvious and, thus, claims 26 and 27, which depend from claim 25, are also not obvious.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. Applicants appreciate and once again thank the Examiner for his review of the subject application.

Respectfully submitted,
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